

## **REMARKS**

This is a full and timely response to the outstanding non-final Office Action mailed November 16, 2004. Through this response, claims 1, 5-7, 9-10, 14-17, 19-21, and 23 have been amended, and claims 8 and 22 has been canceled without prejudice, waiver, or disclaimer. Reconsideration and allowance of the application and pending claims 1-7, 9-21, and 23-24 are respectfully requested.

### **I. Drawings Objection**

The drawings have been objected to under 37 C.F.R. 1.84(p)(5) "because they include the following reference character(s) not mentioned in the description: Figure 1 (132), Figure 4A (300) and (306)." In response to this objection, the specification has been amended to refer to these reference characters. No new matter has been added. In view of the above-noted amendments to the specification, Applicant respectfully submits that the drawings are acceptable and respectfully requests that the objection be withdrawn.

### **II. Specification Amendments**

Various amendments have been made to the specification through this response to correct typographical errors and to provide a correct and accurate description of Applicant's invention as originally disclosed. Although these amendments effect several changes to the specification, it is respectfully asserted that no new matter has been added.

### **III. Claim Rejections - 35 U.S.C. § 102(e)**

#### **A. Statement of the Rejection**

Claims 1-4, 6, 10-13, 15, 19 and 23 have been rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by *Wain et al.* ("Wain," U.S. Pat. No. 6,148,148). Applicant

respectfully traverses this rejection, and in particular, respectfully submits that the rejection is rendered moot in light of the claim amendments.

**B. Discussion of the Rejection**

It is axiomatic that “[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration.” *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983)(emphasis added). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(e).

With regard to independent claim 1, Applicant respectfully submits that *Wain* does not disclose a photograph generation component that “*automatically select an image format for a selected portion of the electronic image file among a plurality of image formats*,” as recited in independent claim 1. The Office Action admits of this deficiency in *Wain* by stating that, “*Wain* does not disclose expressly (claims 5, 14, and 20) wherein the photograph generation software component automatically selects an image format.” Thus, Applicant respectfully requests that the rejection to claim 1 be withdrawn.

Because independent claim 1 is allowable over *Wain*, dependent claims 2-7 and 9 are allowable as a matter of law for at least the reason that the dependent claims 2-7 and 9 contain all elements of their respective base claim. See, e.g., *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

With regard to independent claim 10, Applicant respectfully submits that *Wain* does not disclose “*automatically selecting an image format among a plurality of image formats in which to print the selected electronic image file*,” as recited in independent claim 10. The Office Action admits of this deficiency in *Wain* by stating that, “*Wain* does not disclose expressly (claims 5, 14, and 20) wherein the photograph generation software component

automatically selects an image format.” Thus, Applicant respectfully requests that the rejection to claim 10 be withdrawn.

Because independent claim 10 is allowable over *Wain*, dependent claims 11-18 are allowable as a matter of law.

With regard to independent claim 19, Applicant respectfully submits that *Wain* does not disclose *automatically selecting a portion of the electronic image file based on face recognition* or *automatically scaling the selected image file portion based on a predetermined image format, the predetermined image format corresponding to a passport photograph format*, as recited in independent claim 19. The Office Action refers to column 7, lines 29-46 for the selection feature, and column 8, lines 24-29 for the scaling feature.

These cited sections provide as follows:

The camera 20 and lighting arrangement 27-29 are then automatically actuated to cause a picture (37) to be taken which is displayed frozen on the VDU screen 12. That is, the lighting arrangement 27-29 illuminates the user, and the camera 20 is actuated to take a picture of the user (head and shoulders portrait). There is then a pause during which the user can operate a control 13 to reject the picture and have another picture taken. The pause and the imminence of picture taking may be indicated on the VDU screen 12 e.g. by showing a representation of a count-down clock or the like. [col. 7, lines 29-40]

When the user has obtained a picture to his liking (or two or more pictures if the ‘different’ option was selected) the video image data is stored in memory in the control apparatus 23 superimposed on the background (or backgrounds) already selected by the user or a neutral background if no selection was made. [col. 7, lines 41-46]

Once a representation has been selected the user has the option of operating the user controls 13 to select the positioning of his picture profile against the representation and also to vary the scale by enlarging or reducing his profile relative to the representation as desired. A time limit may be imposed for this procedure. [col. 8, lines 24-29]

With regard to the col. 7 description, *Wain* does not disclose *automatically selecting a portion of the electronic image file based on face recognition*. With regard to the col. 8 description, *Wain* does not disclose *automatically scaling the selected image file portion*.

Thus, Applicant respectfully requests that the rejection to independent claim 19 be withdrawn.

Because independent claim 19 is allowable over *Wain*, dependent claims 20, 21, and 23-24 are allowable as a matter of law.

Due to the shortcomings of the *Wain* reference described in the foregoing, Applicant respectfully asserts that *Wain* does not anticipate Applicant's claims. Therefore, Applicant respectfully requests that the rejection of these claims be withdrawn.

#### **IV. Claim Rejections - 35 U.S.C. § 103(a)**

##### **A. Rejection of Claims 5, 7, 14, 16, 20, 21, 8, 17, 22, 9, 18, and 24**

Claims 5, 7, 14, 16, 20 and 21 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Wain* in view of *Enomoto* ("Enomoto," U.S. Pub. No. 2001/0004406). Claims 8, 17 and 22 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Wain* in view of *Abdel-Mottaleb et al.* ("Abdel-Mottaleb," U.S. Pub. No. 2001/0026633). Claims 9, 18 and 24 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Wain* in view of *Fukushi*. ("Fukushi," U.S. Pat. No. 6,226,105). With respect to the proposed combination of *Wain* and *Enomoto*, independent claims 1, 10, and 19 have been amended to include features found in original dependent claims 5, 14, and 20. With respect to the proposed combination of *Wain* and *Abdel-Mottaleb*, independent claims 1, 10, and 19 have been amended to include features found in original dependent claims 8, 17, and 22. Thus, Applicant respectfully traverses these rejections, and will address the rejections in the context of the amended independent claims, except as otherwise noted.

**B. Discussion of the Rejection**

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office (“USPTO”) has the burden under section 103 to establish a proper case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. See *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Accordingly, to make a proper case for obviousness, there must be a prior art teaching or established knowledge that would suggest to a person having ordinary skill in the pertinent art to fill the voids apparent in the applied reference. It is respectfully asserted that no such case has been made in the outstanding Office Action.

In addition to the above described defects of the rejection, Applicant respectfully asserts that at least some of the proposed combinations are improper. It has been well established that teachings of references can be combined only if there is some suggestion or incentive to do so. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Applicant will initially address the issues of motivation to combine, followed by a discussion of the relevance of some of the proposed combinations (assuming *arguendo* proper combinations) to independent claim elements.

**Proposed Combinations with *Wain* are Improper**

Applicant respectfully submits that the Office Action has failed to set forth a legally complete and proper rejection under 35 U.S.C. § 103(a). Accordingly, the rejection should be withdrawn as a matter of law. In particular, it is well settled law that in order to properly support an obviousness rejection under 35 U.S.C. § 103, there must have been some teaching in the prior art to suggest to one skilled in the art that the claimed invention would have been obvious. *W. L. Gore & Associates, Inc. v. Garlock Thomas, Inc.*, 721 F.2d 1540, 1551 (Fed. Cir. 1983). More significantly,

"The consistent criteria for determination of obviousness is whether the prior art would have suggested to one of ordinary skill in the art that this [invention] should be carried out and would have a reasonable likelihood of success, viewed in light of the prior art. ..." Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure... In determining whether such a suggestion can fairly be gleaned from the prior art, the full field of the invention must be considered; for the person of ordinary skill in the art is charged with knowledge of the entire body of technological literature, including that which might lead away from the claimed invention."

(Emphasis added) In re Dow Chemical Company, 837 F.2d 469, 473 (Fed. Cir. 1988).

In this regard, Applicant notes that there must not only be a suggestion to combine the functional or operational aspects of the combined references, but that the Federal Circuit also requires the prior art to suggest both the combination of elements and the structure resulting from the combination. *Stiftung v. Renishaw PLC*, 945 Fed.2d 1173 (Fed. Cir. 1991). Therefore, in order to sustain an obviousness rejection based upon a combination of any two or more prior art references, the prior art must properly suggest the desirability of combining the particular elements to a system or method for selecting a particular size image to print, and suggest the desirability of combining the particular elements to a method for printing a passport format image, as claimed by the Applicant.

With regard to the proposed combination of *Wain-Enomoto*, the Office Action alleges the following:

Wain & Enomoto are combinable because they are from the same field of endeavor, generation of passport photographs. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the automatic image format selection and main subject extraction of Enomoto with the system of Wain. The suggestion/motivation for doing so would have been to provide the correct print size generation after a user selects the portion of the picture that is to be printed. Therefore, it would have been obvious to combine Enomoto with Wain to obtain the invention as specified in claims 5, 7, 14, 16, 20, and 21.

Applicant respectfully disagrees. Nothing in *Wain* discloses, teaches, or suggests the desirability of automating the selection of a portion of an image or automating the image format.

Rather, the invention in *Wain* appears to encourage considerable user interaction in selecting the desired picture or image format. Also, *Wain* appears to teach a print operation that involves considerable user interaction (see cols. 7-8). In light of these differences in operation and lack of apparent disadvantage in the *Wain* system, Applicant respectfully submits that there is no motivation/suggestion for combining *Wain* and *Enomoto*, and further no motivation/suggestion for combining the automate features of *Enomoto* to the user-interactive system of *Wain*. Significantly, where there is no apparent disadvantage present in a particular prior art reference, then generally there can be no motivation to combine the teaching of another reference with the particular prior art reference. *Winner Int'l Royalty Corp. v. Wang*, No 98-1553 (Fed. Cir. January 27, 2000).

With regard to the proposed combination of *Wain-Abdel-Mottaleb*, the Office Action alleges the following:

*Wain & Abdel-Mottaleb* are combinable because they are from the same field of endeavor, manipulation of digital images. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the face recognition method of Abdel-Mottaleb with the system of *Wain*. The suggestion/motivation for doing so would have been to provide a passport photograph generation system that would ensure the picture that was taken by the user was actually one of the head and shoulders. Therefore, it would have been obvious to combine Abdel-Mottaleb with *Wain* to obtain the invention as specified in claims 8, 17, and 22.

Applicant respectfully disagrees. Nothing in *Wain* discloses, teaches, or suggests the desirability of automating the selection of a portion of an image or automating the image format. Rather, the invention in *Wain* appears to encourage considerable user interaction in selecting the desired picture or image format. In fact, in col. 8, lines 57-67, *Wain* discloses what appears to be a feedback-type system for determining/adjusting for a person's pose, and col. 7 discloses systems in place to ensure the proper picture is taken. The systems in place in *Wain* do appear to ensure that a head and shoulders picture is obtained. Thus, for at least the reason that there is no

apparent disadvantage in the system disclosed in *Wain*, and because of the differences in operation, Applicant respectfully submits that there is no motivation/suggestion for combining *Wain* and *Abdel-Mottaleb*, and further no motivation/suggestion for combining the face-recognition feature of *Abdel-Mottaleb* to the user-interactive system of *Wain*.

With regard to the proposed combination of *Wain-Fukushi*, the Office Action alleges the following:

Wain & Fukushi are combinable because they are from the same field of endeavor, processing images by selected size. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the scanner of Fukushi with the system of Wain. The suggestion/motivation for doing so would have been to allow a preexisting photograph to be used to generate a passport photo. Therefore, it would have been obvious to combine Fukushi with Wain to obtain the invention as specified in claims 8,18, and 24.

Applicant respectfully disagrees. Nothing in *Wain* discloses, teaches, or suggests the desirability of using a scanner. Rather, the invention in *Wain* appears to disclose a picture booth for real-time picture taking, so it would simply not make sense to have a scanner attachment. Thus, Applicant respectfully submits that there is no motivation/suggestion for combining *Wain* and *Fukushi*, and further no motivation/suggestion for combining the scanner of *Fukushi* with the picture booth of *Wain*.

**Obviousness: *Wain-Enomoto***

With regard to independent claim 1, *Wain* does not disclose all of the claim features. Further, *Enomoto* does not remedy these deficiencies. In particular, *Enomoto* does not disclose, teach, or suggest *face recognition software*. Since the proposed combination of *Wain* and *Enomoto* does not disclose, teach, or suggest all of the claim features of the independent claim 1, Applicant respectfully requests that the rejection to claim 1 be withdrawn.

Because independent claim 1 is allowable over the proposed combination, dependent claims 2-7 and 9 are allowable as a matter of law.



With regard to independent claim 10, *Wain* does not disclose all of the claim features. Further, *Enomoto* does not remedy these deficiencies. In particular, *Enomoto* does not disclose, teach, or suggest ***automatically selecting a portion of the electronic image file based on face recognition***. Since the proposed combination of *Wain* and *Enomoto* does not disclose, teach, or suggest all of the claim features of the independent claim 10, Applicant respectfully requests that the rejection to claim 10 be withdrawn.

Because independent claim 10 is allowable over the proposed combination, dependent claims 11-18 are allowable as a matter of law.

With regard to independent claim 19, *Wain* does not disclose all of the claim features. Further, *Enomoto* does not remedy these deficiencies. In particular, *Enomoto* does not disclose, teach, or suggest ***automatically selecting a portion of the electronic image file based on face recognition***. Since the proposed combination of *Wain* and *Enomoto* does not disclose, teach, or suggest all of the claim features of the independent claim 19, Applicant respectfully requests that the rejection to claim 19 be withdrawn.

Because independent claim 19 is allowable over the proposed combination, dependent claims 20, 21, and 23-24 are allowable as a matter of law.

**Obviousness: *Wain* and *Abdel-Mottaleb***

With regard to independent claim 1, *Wain* does not disclose all of the claim features. Further, *Abdel-Mottaleb* does not remedy these deficiencies. In particular, *Abdel-Mottaleb* does not disclose, teach, or suggest ***face recognition software***. Since the proposed combination of *Wain* and *Abdel-Mottaleb* does not disclose, teach, or suggest all of the claim features of the independent claim 1, Applicant respectfully requests that the rejection to claim 1 be withdrawn.

Because independent claim 1 is allowable over the proposed combination, dependent claims 2-7 and 9 are allowable as a matter of law.

With regard to independent claim 10, *Wain* does not disclose all of the claim features. Further, *Abdel-Mottaleb* does not remedy these deficiencies. In particular, *Abdel-Mottaleb* does not disclose, teach, or suggest “*automatically selecting a portion of the electronic image file based on face recognition.*” Since the proposed combination of *Wain* and *Abdel-Mottaleb* does not disclose, teach, or suggest all of the claim features of the independent claim 10, Applicant respectfully requests that the rejection to claim 10 be withdrawn.

Because independent claim 10 is allowable over the proposed combination, dependent claims 11-18 are allowable as a matter of law.

With regard to independent claim 19, *Wain* does not disclose all of the claim features. Further, *Abdel-Mottaleb* does not remedy these deficiencies. In particular, *Abdel-Mottaleb* does not disclose, teach, or suggest “*automatically selecting a portion of the electronic image file based on face recognition.*” Since the proposed combination of *Wain* and *Abdel-Mottaleb* does not disclose, teach, or suggest all of the claim features of the independent claim 19, Applicant respectfully requests that the rejection to claim 19 be withdrawn.

Because independent claim 19 is allowable over the proposed combination, dependent claims 20, 21, and 23-24 are allowable as a matter of law.

In summary, it is Applicant’s position that a proper case for obviousness has not been made against Applicant’s claims 1-7, 9-21, and 23-24. Therefore, it is respectfully submitted that each of these claims is patentable over the proposed combinations and that the rejection of these claims should be withdrawn.

## **V. Canceled Claims**

Claims 8 and 22 have been canceled from the application through this response without prejudice, waiver, or disclaimer. Applicant reserves the right to present these canceled claims, or variants thereof, in continuing applications to be filed subsequently.

**CONCLUSION**

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



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**David Rodack**  
**Registration No. 47,034**